

40059-0010

10/700,714

AMENDMENTS TO THE DRAWINGS

Please substitute the enclosed replacement drawing of Figure 5 for the previous version of drawing sheets including the same figure. The replacement drawing sheet is attached hereto as Appendix A.

The replacement drawing sheet amend Figure 5 by adding reference number "116" to identify a second member. The amendment is fully supported by the original application. No amendments have been made to coincide with these amendments to the drawings.

40059-0010

10/700,714

REMARKS

The non-final Office Action: (1) objected to the drawings because reference numeral 116 is missing therefrom; (2) rejected claims 1, 4, 5, 7-12, 15-23, 34-38, and 44-46 under 35 U.S.C. §112, first paragraph because the specification, while being enabling for an edge constructing apparatus clamped to a form member and wedged to a track, allegedly does not reasonably provide enablement for only a form mating portion and a track mating portion; (3) rejected claims 8, 12, 18-20, 24-33, and 39-44 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; (4) rejected claims 1, 4, 5, 7-12, 15-23, 35, 36, and 38 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,776,501 to Loftin (hereinafter referred to as "Loftin"); (5) rejected claims 1, 4, 5, 7-12, 15-33, 35, 36, 38 40, and 42-45 under 35 U.S.C. §103(a) as being unpatentable over Loftin and U.S. Patent No. 4,967,424 to Stegmeier (hereinafter referred to as "Stegmeier"); and (6) rejected claims 1, 4, 5, 7-12, 15-46 under 35 U.S.C. §103(a) as being unpatentable over the Applicant's admitted prior art and Loftin.

By the forgoing amendment, claims 1, 11, 12, 18-20, 24, 31, 44, and 46 have been amended. No new claims have been added and claims 8, 34, 37, and 39-41 have been cancelled. The amendments presented herein do not introduce new matter. Support for the amendments can be found in Figs. 1-5 of the originally-filed drawings and the corresponding description of these figures in Applicant's originally-filed specification, for example.

Applicant respectfully requests entry of the amendments presented herein into the record. Many of the amendments presented herein have been presented to comply with requirements for

40059-0010

10/700,714

form set forth in the Office Action. (37 CFR § 1.116(b)). Upon entry of the amendments into the record, claims 1, 4, 5, 7, 9-12, 15-33, 35, 36, 38, and 42-46 will be pending with claims 1, 11, 24, and 31 being in independent form. Reconsideration of the presently pending claims is respectfully requested based on the amendments presented herein and for the following reasons.

Objections to the Drawings

On page 2 of the Office Action, the Examiner disapproved of the drawing because Fig. 5 was lacking reference numeral "116" as is included in paragraph 0022 line 11 of the current specification. Consequently, Applicant has submitted an updated version of Fig. 5 including the previously omitted reference numeral "116." For the foregoing reasons, Applicant respectfully requests that the corrected drawing sheets be entered and that the Examiner withdraw the objections to the drawings.

Rejections under 35 U.S.C. §112, First Paragraph

On pages 3 and 4 of the outstanding Office Action, claims 1, 4, 5, 7-12, 15-23, 34-38, and 44-46 were rejected under 35 U.S.C. §112, first paragraph because the specification allegedly "does not reasonably provide enablement for only a form mating portion and track mating portion." Office Action p. 4, lines 2-3. In response to the rejection, Applicant respectfully disagrees with part of the Examiner's rejection. Specifically, it is Applicant's position that, contrary to the assertion made in the outstanding Office Action, removing the coupling member from the form member and the support member would not necessarily cause the form member or

40059-0010

10/700,714

the support member to disengage from the swimming pool due to the force of gravity. However, Applicant has amended independent claims 1, 11, 24, and 31 to recite the "at least one spacer member" in order to satisfy the outstanding rejection based on 35 U.S.C. §112, first paragraph. As all outstanding matters with regard to this rejection have been addressed, reconsideration and withdrawal of the rejection is courteously solicited.

Rejections under 35 U.S.C. §112, Second Paragraph

The outstanding Office Action rejected claims 8, 12, 18-20, 24-33, and 39-44 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention. These claims have been carefully reviewed in light of the Examiner's comments and amended as necessary. Specifically, claims 8, 12, 18-20, and 44 have been amended to further clarify the allegedly ambiguous language. Further, while it is still Applicant's position that independent claims 24 and 31 recited proper method steps not representative of known subject matter, independent method claims 24 and 31 have been amended herein to further recite detailed method steps. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Rejections under 35 U.S.C. § 102

The outstanding Office Action rejected claims 1, 4, 5, 7-12, 15-23, 35, 36, and 38 under 35 U.S.C. § 102(b) as being anticipated by Loftin. For at least the following reasons, the

40059-0010

10/700,714

rejection is respectfully traversed.

As amended, independent claim 1 recites:

An apparatus for constructing an edging for a deck of a swimming pool having a wall and an elongated pool cover track attached to the wall of the swimming pool, comprising:

a reusable form member including an edge forming portion having an inner surface shaped to form the edging and an outer surface and a coupling portion protruding outwardly from the edge forming portion, wherein said reusable form member is a single unitary body,

a support member including a mating portion having a protrusion adapted to be removably coupled to the coupling portion of the reusable form member, and a track mating portion including a track mating feature configured to removably couple the support member to a support mating feature of the elongated pool cover track, the removable coupling of the support member to the form member being substantially pool side of the edge forming surface; and

at least one spacer member sized to be wedged into said pool cover track to secure said support member to said pool cover track.
(Emphasis added).

As illustrated above, independent claim 1 recites a reusable form member having a single unitary body including an edge forming portion and a coupling portion protruding outwardly from the edge forming portion. In contrast to the claimed element, Loftin fails to teach, disclose, or suggest a form member including a single unitary body having both an edge forming portion and a coupling portion protruding outwardly from the edge forming portion. Rather, Loftin clearly teaches an apparatus for coping a wall including a plurality of Z-shaped brackets and a form section. See Loftin Col. 2, lines 33-47. Furthermore, Loftin fails to teach, disclose, or suggest at least one spacer member sized to be wedged into a pool cover track to secure the support member to the pool cover track. Rather, Loftin clearly teaches that the Z-shaped brackets are attached directly to the face of a pool by fasteners. In fact, Loftin does not even disclose or

40059-0010

10/700,714

suggest any interaction of the apparatus with a pool cover track, removably or not. (See Loftin, Col. 2, lines 33-41).

It is well known that "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. As noted above, Loftin, fails to teach, suggest, or disclose all of the claim limitations of independent claim 1. Consequently, for at least the above-mentioned reasons, the outstanding Office Action has failed to make out a prime facie case of anticipation under 35 U.S.C. § 102(b), and the rejection of claim 1, and all claims that depend therefrom based on Loftin should be reconsidered and withdrawn.

Further, independent claims 11, 24, and 31, as amended, also recite similar claim limitations to those of claim 1 such that the arguments made above with respect to claim 1 are equally applicable to independent claims 11, 24, and 31. Consequently, for at least the above-mentioned reasons, the outstanding Office Action has failed to make out a prime facie case of anticipation under 35 U.S.C. § 102(b), and the rejection of claims 11, 24, and 31, as well as all claims that depend therefrom based on Loftin should be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103

A. Rejection of claims 1, 4, 5, 7-12, 15-33, 35, 36, 38, 40, and 42-45 under 35 U.S.C. § 103(a) as being unpatentable over Loftin and Stegmeier.

The outstanding Office Action rejected claims 1, 4, 5, 7-12, 15-33, 35, 36, 38, 40, and 42-45 under 35 U.S.C. § 103(a) as being unpatentable over Loftin and Stegmeier. For at least the

40059-0010

10/700,714

following reasons, the rejection is respectfully traversed.

As amended, independent claim 1 recites:

An apparatus for constructing an edging for a deck of a swimming pool having a wall and an elongated pool cover track attached to the wall of the swimming pool, comprising:

a reusable form member including an edge forming portion having an inner surface shaped to form the edging and an outer surface and a coupling portion protruding outwardly from the edge forming portion, wherein said reusable form member is a single unitary body,

a support member including a mating portion having a protrusion adapted to be removably coupled to the coupling portion of the reusable form member, and a track mating portion including a track mating feature configured to removably couple the support member to a support mating feature of the elongated pool cover track, the removable coupling of the support member to the form member being substantially pool side of the edge forming surface; and

at least one spacer member sized to be wedged into said pool cover track to secure said support member to said pool cover track.
(Emphasis added).

As mentioned previously, independent claims 1, 11, 24, and 31 substantially recite a reusable form member having a single unitary body including an edge forming portion and a coupling portion protruding outwardly from the edge forming portion. Additionally, independent claims 1, 11, 24, and 31 recite at least one spacer member sized to be wedged into a pool cover track to secure the support member to the pool cover track. As mentioned previously, Loftin fails to teach, disclose, or suggest either a form member having a single unitary body including an edge forming portion and a coupling portion or a spacer member sized to be wedged into a pool cover track. Moreover, Stegmeier fails to remedy the shortcomings of the Loftin reference. Specifically, Stegmeier fails to teach or disclose a separate support member having coupling structure to be removably coupled to the form member and adapted to removably couple the form

40059-0010

10/700,714

member to an elongated pool cover track, fails to teach or disclose a single unitary body including an edge forming portion and a coupling portion protruding outwardly from the edge forming portion, and fails to teach or disclose at least one spacer member sized to be wedged into a pool cover track to secure the support member to the pool cover track. Rather, Stegmeier discloses a one-piece edging form that may be coupled to a pool cover track by way of a supporting clip (37) extending inwardly from the edge forming portion. Combining the track mating portion from the single one-piece edging construct of Stegmeier with the Loftin reference fails to teach all the elements of the claimed invention.

It is well known that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Stegmeier in view of Loftin fails to teach or suggest each and every claim limitation. Consequently the rejection of independent claim 1, and all claims that depend therefrom, under 35 U.S.C. § 103(a) as being unpatentable over Loftin and Stegmeier should be reconsidered and withdrawn.

Further, independent claims 11, 24, and 31, as amended, also recite similar claim limitations to those of claim 1 such that the arguments made above with respect to claim 1 are equally applicable to independent claims 11, 24, and 31. Consequently, for at least the above-mentioned reasons, the outstanding Office Action has failed to make out a prima facie case of obviousness under 35 U.S.C. § 103(a), and the rejection of claims 11, 24, and 31, as well as all claims that depend therefrom as being unpatentable over Loftin and Stegmeier should be

40059-0010

10/700,714

reconsidered and withdrawn.

B. Rejection of claims 1, 4, 5, 7-12, and 15-46 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art and Loftin.

The outstanding Office Action rejected claims 1, 4, 5, 7-12, and 15-46 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art and Loftin. For at least the following reasons, the rejection is respectfully traversed.

As amended, independent claim 1 recites:

An apparatus for constructing an edging for a deck of a swimming pool having a wall and an elongated pool cover track attached to the wall of the swimming pool, comprising:

a reusable form member including an edge forming portion having an inner surface shaped to form the edging and an outer surface and a coupling portion protruding outwardly from the edge forming portion, wherein said reusable form member is a single unitary body,

a support member including a mating portion having a protrusion adapted to be removably coupled to the coupling portion of the reusable form member, and a track mating portion including a track mating feature configured to removably couple the support member to a support mating feature of the elongated pool cover track, the removable coupling of the support member to the form member being substantially pool side of the edge forming surface; and

at least one spacer member sized to be wedged into said pool cover track to secure said support member to said pool cover track.
(Emphasis added).

In making the above-mentioned rejection, the outstanding Office Action points to "the Loftin reference which discloses an analogous apparatus which further includes a form member 26, 44 having two separate portions 24, 48 and 46 removably coupled by a clamp 50." However, in contrast to the assertion by the outstanding Office Action, the clamp 50 illustrated in Loftin is

40059-0010

10/700,714

not adapted to "removably couple" a support member with a form member. Rather, the clamp 50, illustrated in Loftin removably couples two portions of the support member. (See Loftin Col. 2, lines 33-41). Furthermore, as mentioned previously, Loftin fails to teach or suggest a reusable form member including and edge forming portion having an inner surface shaped to form the edging and an outer surface and a coupling portion protruding outwardly from the edge forming portion, wherein the reusable form member is a single unitary body. Consequently, the combination of Loftin with the admitted prior art fails to teach or suggest every element of independent claims 1, 11, 24, and 31.

It is well known that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, in light of the above argument, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 4, 5, 7-12, and 15-46 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art and Loftin.

40059-0010

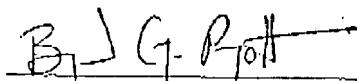
10/700,714

CONCLUSION

For the foregoing reasons, the present application is thought to be in condition for allowance. Accordingly, favorable reconsideration of the application in light of the amendments and remarks provided above is courteously solicited. If any fees are owed in connection with this paper, which fees have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 25 April 2007



Bryan G. Pratt
Registration No. 48,873

Bryan G. Pratt
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-0185
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number 571-273-8300 on April 25, 2007. Number of Pages: 26



Jennifer L. Mundt